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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/714,340	11/16/2000	William N. Weaver	ITW-12833	6496

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EXAMINER	
TRAN, LOUIS B	
ART UNIT	PAPER NUMBER
3721	

DATE MAILED: 08/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/714,340	Applicant(s) WEAVER ET AL.	
	Examiner Louis B Tran	Art Unit 3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-18 is/are pending in the application.

4a) Of the above claim(s) 14-18 is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-13 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I claims 1-13 in Paper No. 4 is acknowledged. The traversal is on the ground(s) that applicant has amended the independent claim to include the phrase "with an applicating machine". This is not found persuasive because the product can still be applied without the use of a specific applicating machine requiring containers spaced at intervals. Adding the limitation "with an applicating machine" does not distinguish between the claimed applicating machine and any other standard applicating machine.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 14-18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 4.

Specification

The disclosure is objected to because of the following informalities: The description of the second length discussed on page 12, line 2 of the specification is ambiguous. It is unclear if the second length is equal to the container pitch 16. If so, clarification is required. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 1 recites the limitation "a second length shorter than the first length spaced apart from an adjacent container by the applicating machine at the first length" in lines 9-11. It is unclear which length (the first or second) is spaced apart from an adjacent container by the applicating machine.

Examiner draws applicant's attention to the specification on page 11, line 7, where a first length is discussed but is not clearly defined or designated a number. If a first length is intended to be equivalent to the longitudinal pitch 18, clarification is required.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,122,893.

Although the conflicting claims are not identical, they are not patentably distinct from each other because Patent No. 6,122,893 includes obvious features to omit.

Claims 1-4 rely on the feature of a carrier having a first longitundinal pitch and a second longitudinal pitch that is shorter when applied to containers. Although, Patent 6,122,893, claims 1-13 of a method, acknowledges a longitudinal pitch it does not specifically name a first pitch or a second pitch.

However, it is inherent in the system claimed in Patent No. 6,122,893 that there would be a first pitch and a second pitch before and after application of the carrier. It is also well known in the art to have varying carrier pitches in order to create a tighter grip on containers.

Claims 5-8 are obvious optimization requirements that are not patentably distinct.

8. Claims 9-13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14-18 of U.S. Patent No. 6,122,893. Although the conflicting claims are not identical, they are not patentably distinct from each other because Patent No. 6,122,893 includes obvious features to omit.

Claims 9 and 10 rely on the feature of a carrier having a first longitundinal pitch and a second longitudinal pitch that is shorter when applied to containers. Although, Patent 6,122,893, claims 14-18 of a system, acknowledges a longitudinal pitch it does not specifically name a first pitch or a second pitch.

However, it is inherent in the system claimed in Patent No. 6,122,893 that there would be a first pitch and a second pitch before and after application of the carrier. It is

also well known in the art to have varying carrier pitches in order to create a tighter grip on containers.

Claims 11-13 are obvious optimization requirements that are not patentably distinct.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krogman et al. (5,383,321) in view of Fisher (3,044,230).

A system for packaging multiple containers comprising the steps of moving a carrier 12 through an applicating machine 10, the carrier 12 constructed of flexible plastic having a plurality of elongated apertures 18 aligned in transverse ranks which elongated apertures are oriented in a longitudinal direction of the carrier and have a longitudinal pitch between a center of each adjacent elongated aperture (as in Figure 3), the longitudinal pitch having a first length, moving a plurality of containers 14 through the applicating machine, positioning the carrier over the plurality of containers whereby each elongated aperture engages with one of the containers to form a package having a container pitch between a center of adjacent containers approximately equal to a

second length (as in claim 1), wherein the carrier further comprises a plurality of relief holes positioned between adjacent longitudinal rows of elongated apertures (as in claim 3), wherein longitudinal extremities of the relief holes overlap end portions of adjacent elongated apertures in the longitudinal direction (as in claim 4) as seen in Figure 3, but does not explicitly show each container of the plurality of containers having a maximum diameter having a second length shorter than the first length spaced apart from an adjacent container by the applicating machine at the first length, and positioning the carrier over the plurality of containers whereby each elongated aperture engages with one of the containers to form a package having a container pitch between a center of adjacent containers approximately equal to the second length (as in claim 1) and elongated apertures in an unstressed condition prior to application to the plurality of containers, are approximately four to six times longer than wide (as in claim 2).

However, Fisher teaches the use of an overall length of a carrier is reduced after the carrier is positioned over a plurality of containers 32 to form a package as seen in Figures 2 compared to Figure 4 (as in claim 8), each container 32 of the plurality of containers having a maximum diameter having a second length (examiner marked Y in Figure 4) shorter than the first length (examiner marked X in Figure 2) spaced apart from an adjacent container at a first length spaced apart from an adjacent container by the applicating machine at the first length (as in claim 1) and elongated apertures in an unstressed condition prior to application to the plurality of containers, are approximately four to six times longer than wide seen in Figure 2 of Fisher (as in

claim 2) for the purpose of forming a tenacious grip on the containers as indicated in column 2, line 67 of Fisher.

Therefore, it would have been obvious to one having ordinary skill in the art to provide Krogman et al. with a first and second length in order to create a tenacious grip withstanding regular wear.

With respect to claim 5, the modified device of Krogman et al. does not explicitly state that the first length is approximately 3.0"; however, it would have been obvious to one having ordinary skill in the art at the time the invention was made to find an optimum first length value, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).*

With respect to claim 6, the modified device of Krogman et al. does not explicitly state that the second length is approximately 2.6"; however, it would have been obvious to one having ordinary skill in the art at the time the invention was made to find an optimum second length value, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).*

With respect to claim 7, the modified device of Krogman et al. does not explicitly state a first length to second length ratio of 1.15; however, it would have been obvious to one having ordinary skill in the art at the time the invention was made to find an optimum first to second length ratio, since it has been held that discovering an optimum

value of a result effective variable involves only routine skill in the art. *In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).*

11. Claims 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krogman et al. in view of Fisher.

Krogman et al. discloses the invention substantially as claimed including a plurality of relief holes positioned between adjacent longitudinal rows of elongated apertures seen in Figure 3 (as in claim 10) an applicating system comprising an applicating machine 10 accommodating a plurality of containers 14 spaced at intervals by the applicating machine and the carrier having adjacent longitudinal rows of elongated apertures with a longitudinal pitch between each elongated aperture, seen in Figure 3, having a first length that is greater than the maximum diameter and, after application to the plurality of containers juxtaposed relative to one another, the container pitch between adjacent containers within the carrier is inherently at a second length but does not show a second length less than the first length and approximately equal to the maximum diameter.

However, Fisher teaches the use of a second length (examiner marked Y) less than the first length (examiner marked X) and approximately equal to the maximum diameter seen in Figures 4 and 2 for the purpose of forming a tenacious grip on the containers as indicated in column 2, line 67 of Fisher.

Therefore, it would have been obvious to one having ordinary skill in the art to provide Krogman et al. with a first and second length in order to create a tenacious grip withstanding regular wear.

With respect to claim 10, the modified device of Krogman et al. does not explicitly state that the first length is approximately 3.0"; however, it would have been obvious to one having ordinary skill in the art at the time the invention was made to find an optimum first length value, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).*

With respect to claim 12, the modified device of Krogman et al. does not explicitly state that the second length is approximately 2.6"; however, it would have been obvious to one having ordinary skill in the art at the time the invention was made to find an optimum second length value, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).*

With respect to claim 13, the modified device of Krogman et al. does not explicitly state a first length to second length ratio of 1.15; however, it would have been obvious to one having ordinary skill in the art at the time the invention was made to find an optimum first to second length ratio, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).*

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Louis B Tran whose telephone number is 703-305-0611. The examiner can normally be reached on 8AM-6PM Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I Rada can be reached on 703-308-2187. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7718 for regular communications and 703-305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

lbt
August 8, 2002

EUGENE KIM
PRIMARY EXAMINER